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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,556	11/09/2001	Satoshi Nishikawa	862.C2433	5909

5514 7590 07/21/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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PATTERSON, RASHAN OMAR

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,556

Applicant(s)

NISHIKAWA ET AL.

Examiner

Rashan O. Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 9, 11, 14, 16, 19 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 5, 7, 8, 10, 12, 13, 15, 17, 18 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

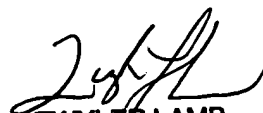
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
TWYLER LAMB  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/16/02

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The drawings are objected to because in Figure 4 "20c" should read "20C" as stated in the specifications on pages 30 and 31. Also in Figure 27 "page 1" should be part of the cover page and not inclusive of the body as stated in the specifications on page 61 lines 17 through page 62 line 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

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corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character not mentioned in the description: Number 31 in Figure 4 representing 'polygonal mirror" on page 29 lines 25 and 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-20 are drawn to a program that

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merely manipulates data or an abstract idea, or merely solves a mathematical problem without limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application it must produce a “useful, concrete and tangible result” *State Street*, 143 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of a “ physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan”, or “limited to a practical application within the technological arts” (MPEP 2106 IVB2(b)). Currently, claim 16 meets neither of these criteria. In order for the claimed process to produce “useful, concrete and tangible” result, recitation of one of the following elements is suggested:

- i. The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- ii. A recitation of a physical transformations outside the computer, for example in the form of pre or post computer processing activity) MPEP 2106 IVB2(b)(i)).
- iii. A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2 (b)(ii)).

Note: In order for computer programs to be considered statutory, they must be contained on a computer readable medium.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 6, 9, 11, 14, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Knodt (US 5,124,731).

With regards to claims 1, 6, 11, 16, Knodt discloses the cover page determination step of determining pages to be imposed cover from input data of plurality of pages (column 6 lines 36-51); the cover imposing processing step of executing imposing process of cover pages on the basis of data the pages determined in the cover page determination step (col. 7 lines 12-44); the bookbinding imposing processing step of executing an imposing process of running text pages the basis of data of the remaining pages which are not imposed the cover pages in the cover imposing processing step (col. 7 line 29 – col. 8 line 34).  
pages.

***Allowable Subject Matter***

7. Claims 2, 3, 5, 7, 8, 10, 12, 13, 15, 17, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Reason of Allowance**

The prior art of record does not render obvious the unique combination: "a first determination means for checking if the total number of pages of print data is not less than  $n$ ; first imposing process means for, when said first determination processing means determines that the total number of pages of print data is not less than  $n$ , executing a first imposing process of cover pages; bookbinding imposing processing means for executing a bookbinding imposing process of the remaining pages after the process of said first imposing processing means; and second imposing processing means for, when said first determination processing means determines that the total number of pages of print data is less than  $n$ , executing a second imposing process of less than  $n$  cover pages."

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morikawa (patent # 5,671,463) shows an image forming apparatus capable of identifying cover page documents and executing a special page mode.

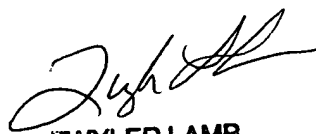
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rashan O Patterson whose telephone number is 571-272-0597. The examiner can normally be reached on 9am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ROP

  
TWYLER LAMB  
PRIMARY EXAMINER